

REMARKS

This amendment responds to the final office action mailed September 10, 2008. In the office action the Examiner:

- objected to the specification, and in particular to failing to provide proper antecedent basis for the claimed subject matter; and
- rejected claims 15-22 and 32-37 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (U.S. 2005/0144157, hereinafter “Moody”).

No changes have been made to the claims. After entry of this amendment, the pending claims include: claims 15-22 and 32-37.

Office Actions in Related Applications

The pending application is related to US Patent Application serial number 10/816,428. An office action on that application was mailed June 26, 2008 and a response was filed October 27, 2008. The Examiner is encouraged to review the art made of record, the Office Action and the response in the above-mentioned related application.

OBJECTIONS TO SPECIFICATION

In the response filed on April 22, 2008, changes were made to paragraph 0143, which Applicant believes addresses the objection to the specification made in the Office Action. No new matter has been added. As revised, paragraph 0143 provides support for the term “computer readable storage medium.”

The Examiner is respectfully requested to acknowledge the previously filed changes to the specification. No new matter has been added.

REJECTION UNDER 35 U.S.C. 103(a)

Claims 15-22 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP §2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Office Action incorrectly interprets claim 15 as having the limitation “identifying at least one conversation (thread).” (See Office Action, page 4.) In contrast, claim 15 is

directed to “identifying a plurality of conversations” relevant to a search query. Moody does not teach:

...**identifying a plurality of conversations relevant to the search query**, the plurality of conversations including at least two conversations each having two or more messages sharing a common set of characteristics that meet predefined criteria and a respective conversation identifier; and
returning to the client a list of the identified conversations as a search result to the search query.
(Claim 15, emphasis added)

The pending claims do not recite “at least one conversation.” Instead, claim 15 is distinguishable from Moody in that it requires “identifying a plurality of conversations” relevant to a search query, not a list of relevant messages of a single thread (which the Office Action refers to as “at least one conversation”). Moody only teaches displaying a single list of messages at one time. In evaluating the claimed embodiments, it is important to note that the definition of a “message” is distinct from that of a “conversation.” The “plurality of conversations” in claim 15 require that “at least two conversations each hav[e] two or more messages.” Thus, the terms “conversation” and “message” are not interchangeable.

The statement in the Office Action (page 4) that:

However, it is clear from the disclosure of Moody that the system will return a list of all conversations satisfying the search criteria..., [w]hile Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody’s disclosure to at least suggest such an embodiment...”

is a conclusion, unsupported by evidence and articulated reasoning. Nowhere does Moody teach organizing and displaying messages into a “list of conversations” as required by claim 15. Figure 2 of Moody discloses a single list of messages 224, Figures 3 and 4 of Moody relate to managing messages in a single thread, and Figure 5 shows a query box 562 for searching only messages belonging to a single thread. The corresponding text in the specification also does not provide for any search result that includes “a plurality of conversations.”

As stated in the 2007 *KSR* decision: “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *In re Kahn*, 441 F. 3d 977, 988 (CA

Fed. 2006). Examiners must avoid the "temptation to read into the prior art the teachings of the invention in issue" and must "guard against slipping into the use of hindsight." *KSR* citing *Graham*, 383 U.S., at 36. It is respectfully submitted that the Office Action fails to provide any reasons that "[w]hile Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment," as evidenced by the fact that no reference was made to particular facts or portions of the Moody reference that show an apparent reason to "permit the search results to include at least two conversations relevant to the search terms."

The pending claims should be allowed because the cited reference does not teach or suggest in any way "identifying a plurality of conversations," and therefore claim 15 and its dependent claims are patentable over Moody. Independent claims 20, 32 and 37, and their dependent claims are patentable over the cited reference for at least the reasons discussed with reference to claim 15.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date: November 10, 2008 / Gary S. Williams / 31,066

Gary S. Williams (Reg. No.)
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306
(650) 843-4000